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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/728,355

12/05/2003

Stephen William Watson Michnick

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12/09/2009

Isaac A. Angres
Suite 301
2001 Jefferson Davis Highway
Arlington, VA 22202

EXAMINER

LIU, SUE XU

ART UNIT

PAPER NUMBER

1639

MAIL DATE

DELIVERY MODE

12/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/728,355	Applicant(s) WATSON MICHNICK ET AL.	
	Examiner SUE LIU	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/25/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,11-14,17,20,21,24,30-33 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,11-14,17,20,21,24,30-33 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

1. Claims 6, 7, 9, 10, 15, 16, 18, 19, 22, 23, 25-29 and 34-36 have been cancelled.

Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are currently pending.

Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are being examined in this application.

Priority

2. This application claims priority benefit as a CIP of U.S. Patent Application Nos. 09/603,885 (filed 6/26/2000), which is now a US PATENT, 6,897,017 (5/24/2005). The US PATENT, 6,897,017 is a CIP of US Patent Application Nos. 09/017,412 (filed 2/02/1998), which is now a US PATENT, 6,270,964 (8/7/2001). This application also claims priority to U.S. Provisional Patent Application Nos. 60/141,210, filed 6/26/1999.

Claim Objection(s) / Rejection(s) Withdrawn

3. All previous claim Objection(s) / Rejection(s) as set forth in the previous Office action (mailed 2/25/09) that are not repeated and/or maintained in the instant Office action are withdrawn.

New Claim Objection(s) / Rejection(s)

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

‘424

5. Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,166,424. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the ‘424 patent read on the instant invention.

The ‘424 patent claims a method or an assay for using fragmented reporter proteins to assay for protein-protein interactions (e.g. claims 6+), which read on the instant claimed invention.

The ‘424 patent also claims the reporter protein can be a green fluorescent protein (e.g. claims 8 and 10) as the term fluorescent protein is defined in the specification to refer to green

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fluorescent proteins or mutants thereof.

'914

6. Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,306,914. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '914 patent read on the instant invention.

The '914 patent claims a method or an assay for using fragmented reporter proteins to assay for protein-protein interactions (e.g. claims 2+), which read on the instant claimed invention.

The '914 patent also claims the reporter protein can be a green fluorescent protein (e.g. claim 4).

'951

7. Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,428,951, if necessary, in view of Ormo et al. (Science. Vol.273: 1392-1395; 1996).

The '951 patent claims a method or an assay for using fragmented reporter proteins to assay for protein-protein interactions (e.g. claims 2+), which read on the instant claimed invention.

The '951 patent also claims the reporter protein can be a green fluorescent protein (e.g. claim 13) as the term fluorescent protein is defined in the specification to refer to green

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fluorescent proteins or mutants thereof. Alternatively, the it would have been prima facie obvious to use green fluorescent protein as the “fluorescent protein” as the GFP protein is known in the art and routinely used as reporter molecule, as taught by Ormo et al.

‘916

8. Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,929,916, if necessary, in view of Ormo et al. (Science. Vol.273: 1392-1395; 1996).

The ‘916 patent claims a method or an assay for using fragmented reporter proteins to assay for protein-protein interactions (e.g. claims 1, 3, etc.), which read on the instant claimed invention.

The ‘916 patent also claims the reporter protein can be a green fluorescent protein (e.g. claim 18) as the term fluorescent protein is defined in the specification to refer to green fluorescent proteins or mutants thereof. Alternatively, the it would have been prima facie obvious to use green fluorescent protein as the “fluorescent protein” as the GFP protein is known in the art and routinely used as reporter molecule, as taught by Ormo et al.

‘543

9. Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 11/656,543 in view of if necessary, in view of Ormo et al. (Science. Vol.273: 1392-1395; 1996).

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The '543 patent claims a method or an assay for using fragmented reporter proteins to assay for protein-protein interactions (e.g. claims 13+), which read on the instant claimed invention.

The '543 patent also claims the reporter protein can be a green fluorescent protein (e.g. claim 17) as the term fluorescent protein is defined in the specification to refer to green fluorescent proteins or mutants thereof. Alternatively, the it would have been prima facie obvious to use green fluorescent protein as the "fluorescent protein" as the GFP protein is known in the art and routinely used as reporter molecule, as taught by Ormo et al.

This is a provisional obviousness-type double patenting rejection.

'543

10. Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 11/656,543 in view of if necessary, in view of Ormo et al. (Science. Vol.273: 1392-1395; 1996).

The '543 patent claims a method or an assay for using fragmented reporter proteins to assay for protein-protein interactions (e.g. claims 13+), which read on the instant claimed invention.

The '543 patent also claims the reporter protein can be a green fluorescent protein (e.g. claim 17) as the term fluorescent protein is defined in the specification to refer to green fluorescent proteins or mutants thereof. Alternatively, the it would have been prima facie obvious to use green fluorescent protein as the "fluorescent protein" as the GFP protein is known

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in the art and routinely used as reporter molecule, as taught by Ormo et al.

This is a provisional obviousness-type double patenting rejection.

'379

11. Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 17, 26 and 35-39 copending Application No. 11/450,379 in view of if necessary, in view of Ormo et al. (Science. Vol.273: 1392-1395; 1996).

The '379 patent claims a method or an assay for using fragmented reporter proteins to assay for protein-protein interactions (e.g. claims 1+), which read on the instant claimed invention.

The '379 patent also claims the reporter protein can be a green fluorescent protein (e.g. claim 35) as the term fluorescent protein is defined in the specification to refer to green fluorescent proteins or mutants thereof. Alternatively, the it would have been prima facie obvious to use green fluorescent protein as the "fluorescent protein" as the GFP protein is known in the art and routinely used as reporter molecule, as taught by Ormo et al.

This is a provisional obviousness-type double patenting rejection.

'694

12. Claims 1-5, 8, 11-14, 17, 20, 21, 24, 30-33 and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-14 copending Application No. 11/987,694.

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The '694 patent claims a method or an assay for using fragmented reporter proteins to assay for protein-protein interactions (e.g. claims 9+), which read on the instant claimed invention.

The '694 patent also claims the reporter protein can be a green fluorescent protein (e.g. claim 12).

This is a provisional obviousness-type double patenting rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Liu whose telephone number is 571-272-5539. The examiner can normally be reached on M-F 9am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached at 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SUE LIU/
Primary Examiner, Art Unit 1639
12/4/09